

-- REMARKS --

The present amendment replies to an Office Action dated August 6, 2008. Claims 1-3 and 5-28 are pending in the present application. In the Office Action, the Examiner rejected pending claims 1-3 and 5-28 on various grounds. The Applicants respectfully request reconsideration of the present application.

35 U.S.C. §103

Obviousness is a question of law, based on the factual inquiries of 1) determining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See MPEP 2143.03. The Applicants respectfully assert that the cited references fail to teach or suggest all the claim limitations.

Claims 1-3 and 5-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,050,207 to Hitchcock (the *Hitchcock* patent) in view of U.S. Patent No. 5,465,206 to Hilt, *et al.* (the *Hilt* patent).

The Applicants respectfully assert that the *Hitchcock* patent and the *Hilt* patent, alone or in combination, fail to teach or suggest all the claim limitations. The Applicants' invention is directed to an electronic payment system and method allowing payment by a single action over any electronic funds transfer network and using any pre-determined local or international electronic funds transfer and settlement network. The *Hitchcock* patent and the *Hilt* patent fail to disclose:

An electronic payment system for a customer to direct payment over an electronic funds transfer network from an originating bank, including means for storing funds transfer static data, the funds transfer static data including identification of the electronic funds transfer network selected by the customer, as recited in independent claim 1;

An electronic payment method for a customer to direct payment over an electronic funds transfer network from an originating bank, including establishing funds transfer static data, the funds transfer static data including identification of the electronic funds transfer network selected by the customer, as recited in independent claim 17; or

A computer readable medium storing a computer program for electronic payment, including computer readable code for establishing funds transfer static data, the funds transfer static data including identification of the electronic funds transfer network selected by the customer, as recited in independent claim 22.

At most, the *Hitchcock* patent discloses a portable automated teller machine which can securely exchange information with a host bank computer. It allows its user to securely access bank and bank accounts and to securely effect either inter-account transfers or bill payments. *See Abstract*. The portable automated teller machine presents a screen requesting selection of checking account, savings account or "other" banking service. *See Figure 11 and 12; column 8, lines 50-53*. The *Hitchcock* patent fails to disclose selection of a funds transfer network by the user or anyone.

The *Hilt* patent also fails to disclose this element. At most, the *Hilt* patent discloses a bill pay system wherein participating consumers pay bills to participating billers through a payment network operating according to preset rules. *See Abstract*. Bill payment order 56 includes authorization for service bureau S to withdraw funds from C's account 22 to pay bill 30, the amount to pay (not necessarily the amount due on bill 30), the date on which to pay, and some indication of biller B as the payee. *See Figure 2; column 7, lines 16-21*.

Claims 2, 3, 5-16, and 24, claims 18-21, 25, and 26, and claims 23, 27, and 28 depend directly or indirectly from independent claims 1, 17, and 22, respectively, and so include all the elements and limitations of their respective independent claims. The Applicants therefore respectfully submit that dependent claims 2, 3, 5-16, 18-21, and 23-28, are allowable over the *Hitchcock* patent and the *Hilt* patent for at least the same reasons as set forth above with respect to their respective independent claims.

Withdrawal of the rejection of claims 1-3 and 5-28 under 35 U.S.C. §103(a) as being unpatentable over the *Hitchcock* patent in view of the *Hilt* patent is respectfully requested.

SUMMARY

Reconsideration of the rejection of claims 1-3 and 5-28 is respectfully requested in light of the remarks herein. The Applicants submit that claims 1-3 and 5-28 fully satisfy the requirements of 35 U.S.C. §§102, 103, and 112. In view of foregoing remarks, favorable consideration and early passage to issue of the present application are respectfully requested.

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Respectfully submitted,

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